

### **REMARKS**

In response to the Office Action dated 1 July 2004, the applicant requests reconsideration of the above-identified application in view of the following remarks. Claims 1-29 are pending in the application, and are rejected. Claims 12, 13, 18, and 29 will be amended upon entry of the present amendment. No new matter has been added.

#### **Claim Amendments**

Claims 12, 13, 18, and 29 are amended herein to provide a proper antecedent basis for some claim elements, and are not amended in response to the prior art rejection. No new matter has been added. This is not a narrowing amendment.

#### **Rejection of Claims Under §102**

Claims 6-11 were rejected under 35 USC § 102(e) as being anticipated by Ogle et al. (U.S. 6,430,604, Ogle). The applicants respectfully traverse.

Ogle issued on 6 August 2002, which is after the filing date of the present application. The applicant does not admit that Ogle is prior art, and reserves the right to swear behind Ogle at a later date.

Claim 6 recites a method comprising receiving an instant message at a destination-client device, wherein the instant message comprises text and determining whether a speech option at the destination-client device is selected and if true converting the text to speech.

Ogle relates to a system “for enabling messaging systems to use alternative message delivery mechanisms.”<sup>1</sup> Ogle shows a transformation engine 404 that is a separate device, not part of the instant message sender 401 or the pager 405.<sup>2</sup> According to Ogle, a message “may optionally pass through a transformation engine before being delivered.” In Ogle, the sender decides if a message “is to be delivered through a non-textual mechanism such as a regular phone. Extended IMS 403 then forwards the message 402b through a text-to-speech transformation process 404....on its way 402c to the destination device.”<sup>3</sup>

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<sup>1</sup> Ogle, Abstract.

<sup>2</sup> Ogle, Figure 4.

<sup>3</sup> Ogle, Column 9, Lines 42-59.

Ogle does not show “a speech option at the destination-client device” where an instant message is received as is recited in claim 6. The sender in Ogle decides if the message is to be transformed. The Office Action refers to the look-up table in Ogle.<sup>4</sup> The look-up table of Ogle does not relate to a speech option, but rather provides information to select a transformation engine based on the type of registered mechanism to receive the message.<sup>5</sup> Ogle does not show all of the features recited in claim 6.

Claim 10 recites a computing device comprising a text-to-speech converter to convert text in a received instant message to speech when a speech option is selected, independent of whether a sender of the instant message performed speech input.

Ogle does not show a sender of an instant message that can perform speech input, and therefore Ogle does not show all of the features recited in claim 10.

The applicants respectfully submit that Ogle does not show all of the features recited in independent claims 6 and 10, and that claims 6 and 10 are in condition for allowance. Claims 7-9 and 11 are variously dependent on claims 6 and 10, and recite further features with respect to claims 6 and 10. For reasons analogous to those stated above, and the features in the claims, the applicant respectfully submits that Ogle does not show all of the features recited in claims 7-9 and 11, and that claims 7-9 and 11 are in condition for allowance.

#### Rejection of Claims Under §103

Claim 11 was rejected under 35 USC § 103(a) as being unpatentable over Ogle in view of Ichikawa et al. (U.S. 4,975,957, Ichikawa). The applicants respectfully traverse.

Ichikawa relates to a “character voice communication system.”<sup>6</sup> The Office Action has not shown that Ichikawa supplies the elements missing in Ogle.

Furthermore, there is no suggestion for combining Ogle with Ichikawa. The Office Action states that:

“it would have been obvious...to implement a speech to text converter as one of Ogle’s interfaces for the purpose of allowing the user a faster and easier way of entering text to be sent.”<sup>7</sup>

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<sup>4</sup> Office Action, page 2.

<sup>5</sup> Ogle, Column 9, Lines 42-59.

<sup>6</sup> Ichikawa, Title.

<sup>7</sup> Office Action, page 3.

The MPEP requires a suggestion and a reasonable expectation of success for a rejection under 35 USC § 103:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”<sup>8</sup>

The suggestion or motivation to combine references and the reasonable expectation of success must both be found in the prior art.<sup>9</sup>

Ichikawa describes the functions of a word processor and a teletex combined,<sup>10</sup> but does not relate to instant messaging as described in Ogle. The Office Action has not identified prior art as being the source of the quote above from the Office Action as is required by MPEP 2143. The Office Action has also not identified a reasonable expectation of success in the prior art as is required by MPEP 2143.

The Office Action also states that:

“Ogle’s method in view of Ichikawa’s teachings inherently comprises determining whether a speech option is selected or not for the purpose of allowing the sender to select which input method to use when sending the instant message.”<sup>11</sup>

The MPEP states that missing matter must be “necessarily present” in the reference to support a rejection based on inherency:

“To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”<sup>12</sup>

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<sup>8</sup> MPEP 2143.

<sup>9</sup> MPEP 2143.

<sup>10</sup> Ichikawa, Column 2, lines 36-42.

<sup>11</sup> Office Action, page 3.

<sup>12</sup> MPEP 2112.

The MPEP further states that the examiner must provide a basis to support a determination that the allegedly inherent characteristic necessarily flows from the teaching of the art:

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”<sup>13</sup>

The Office Action has not provided a sufficient basis in fact and/or technical reasoning to reasonably support its contention that “determining whether a speech option is selected” would be inherently present in a device based on a combination of Ogle and Ichikawa.

The applicants respectfully submit that a *prima facie* case of obviousness has not been established against claim 11, and that claim 11 is in condition for allowance.

Claims 1-5, 12-26, 28, and 29 were rejected under 35 USC § 103(a) as being unpatentable over Ogle in view of Ichikawa. The applicants respectfully traverse.

With reference to the remarks made regarding claim 11 above, the Office Action has not shown that Ichikawa supplies the elements missing in Ogle. The Office Action states that:

“it would have been obvious...to implement a speech to text converter as one of Ogle’s interfaces for the purpose of allowing the user a faster and easier way of entering text to be sent.”<sup>14</sup>

The Office Action has not identified prior art as being the source of this quote from the Office Action as is required by MPEP 2143. The Office Action has also not identified a reasonable expectation of success in the prior art as is required by MPEP 2143.

The Office Action also states that:

“Ogle’s method in view of Ichikawa’s teachings inherently comprises determining whether a speech option is selected or not for the purpose of allowing the sender to select which input method to use when sending the instant message.”<sup>15</sup>

The Office Action has not provided a sufficient basis in fact and/or technical reasoning to reasonably support its contention that “determining whether a speech option is selected” would be inherently present in a device based on a combination of Ogle and Ichikawa.

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<sup>13</sup> MPEP 2112. Emphasis in original.

<sup>14</sup> Office Action, page 4.

<sup>15</sup> Office Action, page 4.

The applicants respectfully submit that a *prima facie* case of obviousness has not been established against claims 1-5, 12-26, 28, and 29, and that claims 1-5, 12-26, 28, and 29 are in condition for allowance.

Claim 27 was rejected under 35 USC § 103(a) as being unpatentable over Ogle in view of Ichikawa and Parvulescu et al. (U.S. 5,724,410, Parvulescu). The applicants respectfully traverse.

Parvulescu relates to a voice messaging terminal having a text-to-speech converter.<sup>16</sup> Parvulescu does not relate to instant messaging. The Office Action has not shown that Parvulescu supplies the elements missing in Ogle.

The Office Action states that:

“it would have been obvious...that Ogle’s pager could comprise a speech-text converter for the purpose of allowing the user of the pager to respond to a page by using their voice.”<sup>17</sup>

The Office Action has not identified prior art as being the source of this quote from the Office Action as is required by MPEP 2143. The Office Action has also not identified a reasonable expectation of success in the prior art as is required by MPEP 2143.

The applicants respectfully submit that a *prima facie* case of obviousness has not been established against claim 27, and that claim 27 is in condition for allowance.

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<sup>16</sup> Parvulescu, Abstract.

<sup>17</sup> Office Action, page 6.

**CONCLUSION**

The applicants respectfully submit that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at 612-373-6973 to discuss any questions which may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

NIKHIL M. DESHPANDE ET AL.

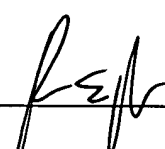
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Date 1 September 2004

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 1 day of September, 2004.

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